

### **REMARKS**

In response to the Office Action dated July 17, 2006, claims 1, 3, 6, 7, 32, 40, 42, 45, 46, 71, 79 and 80 have been amended, and claim 4, 5, 43 and 44 have been canceled. Claims 1-3, 6-35, 40-42, 45-74, 79 and 80 are now pending in this application. No new matter has been added. Claims 36-39 and 75-78 have been withdrawn from consideration as being directed to a non-elected invention.

Claims 3 and 42 have been amended to change "...have their order for execution..." to "have a certain order for execution..." to provide better form.

### **REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103**

I. Claims 1-9, 11, 15-23, 30, 32, 34, 40-48, 50, 54-62, 69, 71, 73, 79 and 80 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Fritsch (USPN 6,247,130).

The rejections of claims 5 and 44 are respectfully traversed.

Anticipation, under 35 U.S.C. § 102, requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

It is believed that the feature of "the ID information of sub-application to be utilized next that is stored in the executed sub-application" described in dependent claims 5 and 44 is not disclosed or suggested in Fritsch (or Kupka et al. (USPN 6,434,535)). Consequently, the feature that the order for execution of the sub-applications is readily extracted based on the ID information of sub-application to be utilized next that is stored in the executed sub-application is not obtained from Fritsch (or Kupka et al.).

Therefore, claims 5 and 44 are patentable over Fritsch.

To expedite prosecution, independent claim 1 has been amended to include the limitations of claims 4 and 5, independent claim 40 has been amended to include the limitations of claims 43 and 44, claims 4, 5, 43 and 44 have been cancelled, claims 6 and 7 have been amended to depend from amended independent claim 1, and claims 45 and 46 have been amended to depend from amended independent claim 40. Consequently, claims 1-3, 6-9, 11, 15-23, 30, 40-42, 45-48, 50, 54-62 and 69, as amended, are believed to be allowable.

In addition, independent claims 32, 71, 79 and 80 have been amended in manner similar to that of independent claims 1 and 40. Consequently, independent claims 32, 71, 79 and 80, as amended, as well as dependent claim 73, are patentable over Fritsch also, and their allowance is respectfully solicited.

**II.** Claims 10, 12-14, 31, 33, 49, 51-53, 70 and 72 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Fritsch. The Examiner admits that Fritsch does not disclose the features recited in these claims, but asserts, "However those features are well known in the art. ... Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Fritsch's to adopt the well-known features above, for the purpose of providing incentive to the consumers in order to encourage the consumers to purchase the products or services."

The rejections are respectfully traversed, notwithstanding the fact that amended independent claims 1, 32, 40 and 71 are patentable over Fritsch and claims 10, 12-14, 31 depend indirectly from amended independent claim 1, claim 33 depends directly from amended

independent claim 32, claims 49, 51-53 and 70 depend indirectly from amended independent claim 40, and claim 72 depends directly from amended independent claim 71.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by *Graham v. John Deere Co.*, 86 S.Ct. 684, 383 U.S. 117, 148 USPQ 459, 469 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or to combine applied references to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

While the Examiner contends that each of the features recited in claims 10, 12-14, 31, 33, 49, 51-53, 70 and 72 is well-known in the art, it is significant that no reference is cited by the Examiner supporting this assertion. Thus, the assertion by the Examiner that each of the features recited in claims 10, 12-14, 31, 33, 49, 51-53, 70 and 72 is well-known in the art is not based on any objective evidence of record and, therefore, lacks substantial evidence support and must be considered merely the opinion of the Examiner.

In this regard, the issue of merely asserting something to be “common knowledge” (which is equivalent to the Examiner’s assertion in the present Office Action that the features are

well-known in the art) without supporting evidence was decided by the Federal Circuit in the case of *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001), overturning a decision of the Board of Patent Appeals and Interferences. Further supporting evidence that the Federal Circuit requires objective evidence of record, not opinion by the Examiner (or Board), can be found in case of *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

In addition, the Examiner's assertion "for the purpose of providing incentive to the consumers in order to encourage the consumers to purchase the products or services" as a motive for modifying Fritsch with the features recited in claims 10, 12-14, 31, 33, 49, 51-53, 70 and 72 (alleged to be "well-known") is also not based upon any objective evidence of record. However, in establishing the requisite motivation, it has been consistently held that both the suggestion and the reasonable expectation of success must stem from the prior art itself, as a whole. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). Furthermore, what may be known in some general context does not necessarily render the claimed subject matter as a whole obvious within the meaning of 35 U.S.C. § 103.

It is Applicants' position that, in view of the lack of any objective evidence of record regarding the Examiner's allegation that each of the features recited in claims 10, 12-14, 31, 33, 49, 51-53, 70 and 72 is well-known, and the lack of any objective evidence of record supporting the allegation that a person of ordinary skill in the art would adopt the well-known features recited in claims 10, 12-14, 31, 33, 49, 51-53, 70 and 72 into Fritsch "for the purpose of providing incentive to the consumers in order to encourage the consumers to purchase the products or services", the only reasonable conclusion is that the present rejections are examples

of improper hindsight reconstruction of the claimed invention which do not support a *prima facie* case that claims 10, 12-14, 31, 33, 49, 51-53, 70 and 72 are obvious over Fritsch under 35 U.S.C. § 103.

**III.** Claims 24-29, 35, 63-68 and 74 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Fritsch in view of Kupka et al. (USPN 6,434,535).

Claims 24-29 depend directly or indirectly from amended independent claim 1, claim 35 depends indirectly from amended independent claim 32, claims 63-68 depend directly or indirectly from amended independent claim 40, and claim 74 depends indirectly from amended independent claim 71. As noted above, Kupka et al. does not disclose the feature of “the ID information of sub-application to be utilized next that is stored in the executed sub-application” now recited in amended independent claims 1, 32, 40 and 71. Therefore, claims 24-29, 35, 63-68 and 74 are patentable over Fritsch also, even when considered in view of Kupka et al. Consequently, the allowance of claims 24-29, 35, 63-68 and 74 is respectfully solicited.

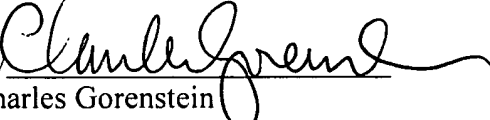
### **CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Edward J. Wise (Reg. No. 34,523) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: October 17, 2006

Respectfully submitted,

By 

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